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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389 7590 06/19/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PHAN, HUY Q				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/589,217

**Applicant(s)**

COOPER, DAVID

**Examiner**

HUY Q. PHAN

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05/26/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28, 29, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is in response to Amendment filed on date: 06/17/2009.  
Claims 28, 29, 32 and 33 are still pending.  
Claims 1-27 and 30-31 have been cancelled.

***Response to Arguments***

**2. Rejection of Claims Under 35 USC 101**

Applicant has amended independent claim 28 to make the steps clearly machine implemented (see LISTING OF CLAIMS page 2), therefore the 101 rejection is withdrawn.

**II) Rejection of Claims Under 35 USC 103**

Applicant argued that "Lynch does not teach or suggest "receiving a message that includes a first list including a plurality of network identifiers that are available for potential handover from the communication network" as recited in the claims of the present invention" (see REMARKS page 5). The examiner respectfully disagrees with the applicant's argument. Lynch specifically discloses the updating method for downloading new system identification (SID) list into a mobile phone (see the title) during the handoff ("hand-off" see col. 8, lines 8-10, line 41; col. 11, lines 55-58; col. 12, lines 1-5 and fig. 5). Since, figure 5 of Lynch particularly shows that the mobile phone could receive a preferred SID list (read on the claimed limitation "a first list") which is

available for hand-off (see col. 12, lines 2-5) from the communication network (see col. 11, lines 53-58 and fig. 1), while a call is in progress ("hand-off sequence" see col. 12, lines 1-2); therefore, Lynch discloses the claimed limitations "receiving a message that includes a first list including a plurality of network identifiers that are available for potential handover from the communication network while a call is in progress".

In response to the applicant's argument, with regard to establish *prima facie*, it is believed that Lynch and Daly and Granghi disclose each and every feature of the present invention as recited in the claims 28, 29, 32 and 33 (see the explanation in the above section and the rejection in the below section). Thus, the combination of Lynch and Daly and Granghi can be used to establish *prima facie* obviousness for claims 10, 21 and 27 because the cited references teach or suggest all claim limitations as required. See MPEP § 2143.03. Therefore, *prima facie* obviousness under 35 U.S.C. § 103 has been established.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Daly (US-6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message on said user equipment including a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available for a potential handover ("hand-off", col. 12, lines 1-5), said receiving from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list stored in the equipment ("stored"; col. 12, lines 1-5), said second list including at least one network identifier ("received SIDs"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

means for comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 33, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

a receiver (fig. 1, 12) for receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-5) that are available for a potential handover ("hand-off" see col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5);  
and

a comparator (fig. 1, 12) for comparing ("compared", col. 12, lines 1-5) the received first list with a second list ("received SIDs"; col. 12, lines 1-5) which includes at least one network identifier and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280; previously cited).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5);

means for comparing ("compared", col. 12, lines 1-5) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-5) and is internally stored in the user equipment ("stored"; col. 12, lines 1-5); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (fig. 5, step 507-510 and col. 11, lines 7-20).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the



invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying to the user equipment neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information"; see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Kallioniemi discloses that "exchange to route the calls through, either randomly or by other criteria, such as time of day called party, time of day calling party,

calling party number, called party number, black list of called party, white list of called party" (see specification)

b) Bruckert discloses that "the system must take into account to re-configure itself might include: control vs traffic channel bunching, physical cell vs logical cell configurations, movable channel sets vs stationary channel sets, lists of unusable channels in each cell dynamically updated, list of potential handover channels in each cell dynamically updated, etc." (see specification).

c) Wild discloses that "If the access server decision indicates that access is denied (step 1512), the SU will receive from the network a list of other accessible networks which the SU is allowed to access in step 1520. At times, there will be no other accessible networks and the SU could receive either an empty list, or could an access indicator that no other accessible networks are available to the SU. (see specification).

d) Sandvos discloses that "A determination of whether the roam system is already providing service to this PT is made at decision block 709, where a positive response to this decision allows the PT communications to be processed normally at 711. A negative response moves to step 713. If the PT is to be denied service in this system, such as for nonpayment of bills, a determination is made at step 713 whether this PT is on the "black list" of undesirable units kept as part of the foreign roamer list" (see specification).

e) Rahmen discloses that "a restricted list of candidate base stations can be

examined for macrodiversity and/or handoffs, and the active set could be limited when compared to a fully mobile wireless unit. Another parameter to determine whether a fixed (or limited fixed) wireless unit can enable macrodiversity and/or handoffs is the load on the cell 32 and/or of the surrounding cells" (see specification).

5. **THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 9AM-7:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/  
Primary Examiner, Art Unit 2617  
Date: 06/17/2009